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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : PETER J. SALLAWAY, ET AL.

U.S. Serial No. : 09/751,037

Filed : December 29, 2000

For : SYSTEMS FOR MONITORING AND CONTROLLING
OPERATING MODES IN AN ETHERNET TRANSCEIVER AND
METHODS OF OPERATING THE SAME

Group No. : 2616

Examiner : Ian N. Moore

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
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APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41

The Appellants file this Reply Brief Under 37 C.F.R. § 41.41 in response to the Examiner's Answer dated September 19, 2006 and the Supplemental Examiner's Answer dated October 17, 2006.

ARGUMENTS IN RESPONSE TO THE EXAMINER'S ANSWER

All arguments and analysis of the Substitute Appeal Brief filed November 16, 2005 are re-urged and incorporated by reference herein. The remarks and arguments made below are in specific response to the Examiner's Answer dated September 19, 2006 and the Supplemental Examiner's Answer dated October 17, 2006. The prior art references described below are U.S. Patent No. 5,740,163 to Herve ("Herve") and U.S. Patent No. 6,721,916 to Agazzi ("Agazzi").

Disclosure of Herve

The Examiner cites various portions of *Herve* as allegedly disclosing various elements recited in Claim 1. However, none of these portions of *Herve* anticipates a "decoder portion" that directs an encoder portion to direct an encoder to encode data in a custom mode "in response to sensing data received in [the] custom mode at [a] decoder" as recited in Claim 1.

In the following discussion, reference is made to the "encoders" and "decoders" of *Herve*. These encoders and decoders form the codecs 6, 13, 24, and 25 shown in Figure 1 of *Herve*. The codecs 6 and 13 represent ISDN encoders and decoders, and the codecs 24 and 25 represent STN encoders and decoders. (*Col. 2, Lines 28-61; Col. 3, Lines 41-56*). The ISDN codecs 6 and 13 are used in "RNIS" or "ISDN" mode, while the STN codecs 24 and 25 are used in "RTC" or "STN" mode (Figure 1 uses the "RNIS" and "RTC" symbols with the ISDN and STN codecs, respectively).

None of the cited portions of *Herve* relied upon by the Examiner discloses selecting the mode for an encoder in response to sensing data received in that mode at a decoder. Many of the portions

cited by the Examiner were previously discussed in the Appellants' appeal brief. For example, the Examiner cites column 3, line 63 through column 4, line 5. (*Supplemental Examiner's Answer, Page 12, Last paragraph*). This portion of *Herve* simply recites that a switch 28 is used to select either ISDN mode or STN mode for a visiophone terminal (*Col. 3, Lines 62-64*), an STN signaling unit 29 controls a visiophone call (*Col. 3, Line 66 – Col. 4, Line 1*), and a RAM 30 supports answering and recording functions. (*Col. 4, Lines 1-5*). Nothing here indicates that the visiophone terminal of *Herve* "senses" data received in a particular "mode" at a "decoder" and then directs an encoder to encode data using that "mode."

The Examiner also cites column 3, lines 40-65 of *Herve*. (*Supplemental Examiner's Answer, Page 12, Third paragraph*). However, this portion of *Herve* simply recites how the visiophone terminal is configured in STN mode. (*Col. 3, Lines 40-65*). Again, nothing here indicates that the visiophone terminal of *Herve* "senses" data received in a particular "mode" at a decoder and then directs an encoder to encode data using that "mode."

The Examiner further cites various figures of *Herve*, such as Figures 1 and 2. (*Supplemental Examiner's Answer, Pages 12-13*). However, none of these figures discloses that the mode of an encoder is determined based on sensing data received in that mode at a decoder.

The Examiner then argues that the encoders and decoders of *Herve* need to be synchronized. (*Supplemental Examiner's Answer, Page 13, Last paragraph*). While this may be true, it does not establish that *Herve* selects the mode for an encoder based on sensing data received in that mode at a decoder.

The Examiner notes that if data is encoded in “RTC mode” by the encoder of *Herve* in response to switching to “RTC mode,” the decoder must then decode data in “RTC mode.” (*Supplemental Examiner’s Answer, Page 14, First paragraph*). Again, even if this is true, it does not establish that *Herve* selects “RTC mode” for an encoder based on sensing data received in “RTC mode” at a decoder.

Moreover, the Examiner’s very next assertion is that *Herve* clearly discloses that the particular mode of the visiophone is based on sensing/receiving data in that particular mode at a decoder, which is completely unsupported in *Herve*. The Examiner cannot cite a single portion of *Herve* showing that the mode used by an encoder is based on sensing data received in that mode at a decoder. It is important to note that the Examiner cites no portion of *Herve* following the Examiner’s assertion that *Herve* “clearly discloses that the particular mode … is selected by sensing/receiving/data received in that particular mode at a decoder.” (*Supplemental Examiner’s Answer, Page 14, First paragraph*).

The Examiner notes that the management system 18 of *Herve* controls a switch 28, which is used to select the mode of the visiophone terminal of *Herve*. (*Supplemental Examiner’s Answer, Page 14, Last paragraph – Page 15, First paragraph*). However, the management system 18 of *Herve* appears to use the signaling for a telephone call to determine the appropriate mode of operation. (See, e.g., *Figure 1; Col. 3, Lines 19-40; Col. 3, Line 66 – Col. 4, Line 1*). The signaling (and therefore the type of telephone call) must be determined before any voice information is received at the visiophone of *Herve*. This is because the telephone call must first be established

before the voice information can be transported as part of that telephone call. Therefore, *Herve* appears to contemplate using the signaling information for a telephone call to establish the appropriate mode (ISDN/RNIS mode or STN/RTC mode) for that call. Once the appropriate mode is determined, the switch 28 is set, and the appropriate encoders and decoders are used to facilitate the telephone call. Note that this absolutely does not, in any way, involve setting the mode of an encoder by sensing data received in that mode at a decoder.

In fact, the structure of the visiophone terminal in *Herve* conflicts with the way in which the Examiner asserts that *Herve* operates. In *Herve*, incoming data is decoded by the appropriate ISDN or STN decoders. The only way for the appropriate decoders to receive data is for the switch 28 to be set to the appropriate position. The appropriate mode of the visiophone terminal would therefore be determined in order to set the switch properly, which means the appropriate mode is determined before any voice data is provided to the appropriate decoders. There is no need in *Herve* to “sense” the mode of data received at a decoder (in order to identify the proper mode of an encoder in *Herve*) since the mode has already been determined in order to set the switch 28.

Overall, the Examiner has simply established that the different encoders and decoders of *Herve* can be used to encode and decode data in different modes. The specific mode used in *Herve* is determined by the position of a switch 28. The Examiner has simply assumed that the position of the switch 28 is based on sensing/detecting/receiving data in that mode at a decoder. The Examiner fails to show that this assumption is supported in *Herve*. This is inadequate under 35 U.S.C. § 102 since the burden is on the Examiner to show that *Herve* expressly or inherently discloses all elements

recited in Claim 1. As shown above, *Herve* does not expressly disclose directing an encoder portion to direct an encoder to encode data in a particular mode “in response to sensing data received” in that particular mode “at [a] decoder” as recited in Claim 1. Moreover, given the apparent way in which *Herve* operates, the Examiner cannot show that *Herve* inherently discloses directing an encoder portion to direct an encoder to encode data in a particular mode “in response to sensing data received” in that particular mode “at [a] decoder” as recited in Claim 1. For example, the Examiner cannot establish that “RTC mode” in *Herve* is selected by sensing data received in “RTC mode” at the RTC codecs 24 and 25. The Examiner simply shows that the appropriate encoders and decoders are used if “RTC mode” is selected based on the position of a switch 28, which appears to be controlled using signaling messages received by the management system 18. This fails to establish that “RTC mode” is selected in *Herve* “in response to sensing” data received in “RTC mode” at a decoder.

For these reasons, the Examiner fails to establish that *Herve* anticipates all elements recited in Claim 1, and Claim 1 and its dependent claims are patentable over *Herve*. Similarly, the Examiner fails to establish that *Herve* anticipates analogous elements recited in Claims 9, 18, and 26, so Claims 9, 18, and 26 and their dependent claims are patentable over *Herve*.

Accordingly, the Appellants respectfully request withdrawal of all outstanding rejections and full allowance of Claims 1-38.

SUMMARY

The Appellants have demonstrated that the present invention as claimed is clearly distinguishable over the prior art cited of record. Therefore, the Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is hereby authorized to charge any fees (including any extension of time fees) or credit any overpayments to Deposit Account No. 50-0208.

Respectfully submitted,

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